

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Dated: October 14, 2003

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JOHNATHAN R. VOGT
and KIRSTEN B. WISDOM

HP Docket No. 10992740-1

Serial No. : 09/629,254

Group Art Unit 3625

Filed : July 31, 2000

Examiner Jeffrey A. Smith

For : SYSTEM AND METHOD FOR FACILITATING THE
PURCHASE OF COMPATIBLE PRODUCTS

Commissioner for Patents
P. O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

RESPONSE TO OFFICE ACTION

Reconsideration of the Office action dated July 17, 2003 and allowance of all pending claims are respectfully requested in view of the following remarks.

Applicants note initially that claims 1-9, 13-21, and 29-33 stand rejected under 35 USC 102(b) as being anticipated by "Oil Change Online" (as evidenced by "McAfee.com Debuts Oil Change Online—the Internet's First Contextual Shopping and Update Service for PC Software, Hardware and Accessories", May 7, 1999 Press Release [hereafter "Press Release"]; and "Company Overview", May 7, 1999). Claims 10-12 and 22-28 stand rejected under 35 USC 103(a) as unpatentable over "Oil Change Online" in view of "Feature Finder" (as evidenced by "Feature Finder", VARbusiness, Manhasset, February 1, 1995).

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Rejections under 35 USC 102(b)

Applicants respectfully traverse the rejections of claims 1-9, 13-21, and 29-33 based on 35 USC 102(b) as being anticipated by Oil Change Online. "A prior art reference anticipates a patent claim if the reference discloses, either expressly or inherently, all of the limitations of the claim." *EMI Group North America, Inc. v. Cypress Semiconductor Corp.*, 268 F.3d 1342, 1350 (Fed. Cir. 2001). In other words, "exclusion of a claimed element from a prior art reference is enough to negate anticipation by that reference." *Atlas Powder Co. v. E. I. du Pont de Nemours & Co.*, 750 F.2d 1569, 1574 (Fed. Cir. 1984).

Claims 1-9 stand rejected under 35 USC 102(b) as being anticipated by "Oil Change Online." Claim 1 relates to a computer-enabled method of facilitating the purchase of products compatible with a component of the user's processor system. In particular, claim 1 recites "informing a remote server system via a communications network of the particular type of component." Oil Change Online excludes at least this element. Oil Change Online instead "is deployed through a ... process during which all information about the user's PC stays strictly within the users [sic] system" (Press Release). Specifically, the Oil Change Online method downloads a database of supported products and services, "which is analyzed locally" within the user's system, and "is never exposed or sent" via the Internet to any remote system. *Id.* Since claim 1 recites informing a remote server via a communications network (such as the Internet) of information about a user's system, Oil Change Online does not anticipate claim 1 for at least this reason.

Claim 1 also recites "identifying one or more vendors offering to sell products compatible for use with the particular type of component." Oil Change Online also

excludes at least this element. The Examiner has noted that the reference discloses that "McAfee.com has created alliances with partners such as Beyond.com and Fatbrain.com to handle fulfillment and transaction processing" (Press Release). Applicants respectfully note that this disclosure does not designate the named partners as "vendors." More importantly, although the disclosure mentions that McAfee.com itself has partnered with Beyond.com and Fatbrain.com, the disclosure fails to specify that any feature of the Oil Change Online service identifies either of these entities as offering to sell the compatible products. Since claim 1 recites identification of one or more vendors offering to sell products compatible with the particular type of component, Oil Change Online does not anticipate claim 1 for at least this reason.

For at least the aforementioned reasons, claim 1 is not anticipated by Oil Change Online, and is in condition for allowance. Moreover, claims 2-9 depend from and include all of the features of claim 1, and thus also are not anticipated by Oil Change Online.

Claims 13-21 also stand rejected under 35 USC 102(b) as being anticipated by "Oil Change Online." Similar to claim 1, claim 13 recites "a purchase request specifying the particular type of the component [of the processor system] via a communications network" and a server system configured to receive the purchase request and "identifying one or more vendors offering to sell products compatible for use with the particular type of component." As discussed above, Oil Change Online expressly excludes communication of information regarding the user's processor system including the particular type of any component of the processor system. Oil Change Online also does not identify any "vendors" offering to sell compatible products, but rather simply downloads a database of its own supported products and services. Oil

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Change Online does not anticipate claim 13. Moreover, claims 14-20 depend from and include all of the features of claim 13, and thus also are not anticipated by Oil Change Online.

Claim 21 recites "informing a remote server system of the particular type of the peripheral device [of the processor system] via a communications network." As discussed above, Oil Change Online expressly indicates that no such communication occurs. Accordingly, Oil Change Online does not anticipate claim 21.

Finally, claims 29-33 stand rejected under 35 USC 102(b) as being anticipated by "Oil Change Online." However, claims 29-33 depend from and include all of the features of claim 21. As discussed above, Oil Change Online does not anticipate claim 21. Claims 29-33 thus also are not anticipated by Oil Change Online.

Rejections under 35 USC 103(a)

Applicants respectfully traverse the rejections of claims 10-12 and 22-28 as being obvious over Oil Change Online in view of Feature Finder. For a claim to be obvious over a combination of references, each element of the claim must be either disclosed or suggested by the combination of references. However, none of the rejected claims is obvious over these references because the references cannot be combined to produce a system or method of facilitating the purchase of compatible products having all of the elements in any of the rejected claims.

Claims 10-12 stand rejected under 35 USC 103(a) as unpatentable over Oil Change Online in view of Feature Finder. Claim 10 depends from claim 1 and thus includes the subject matter of claim 1. Claim 1 recites a computer-implemented method of enabling the purchase of products for use with a component of the user's processor system. Claim 10 specifies that the component is a printer.

As discussed above, Oil Change Online discloses a contextual shopping service deployed through a process "during which all information about the user's PC stays strictly within the users [sic] system and is never exposed or sent" via a communications network to a remote server (Press Release). Feature Finder discloses printer maintenance software that monitors levels of maintenance items and flashes a contact information number when maintenance is needed. Neither reference discloses a method in which information about the user's processor system (for example, information about the printer component) is transmitted via a communications network to a remote server. Specifically, Feature Finder makes no reference to communication apart from flashing a contact number at the user, and Oil Change Online details the process as commencing with downloading a database of products, which is "analyzed locally" within the user's system, rather than being communicated to a remote server (Press Release). In fact, Oil Change Online emphasizes that users are "assured that [McAfee.com has] gone to great lengths to protect the privacy of their online experience." *Id.* Thus, the combination of Oil Change Online with Feature Finder fails to produce a system or method having all of the features of claim 10.

In fact, as indicated above, Oil Change Online teaches away from such a system or method, since incorporating the communicating information about the user's printer component with a remote server would defeat the stated purpose of protecting the privacy of information about a user's system, as offered by the Oil Change Online system (see Press Release). Claim 10 is therefore not obvious over these references. Moreover, claims 11 and 12 depend from and include all of the features of claim 10, and are thus also not obvious over Oil Change Online and Feature Finder.

Claims 22-28 also stand rejected under 35 USC 103(a) as unpatentable over Oil Change Online in view of Feature Finder. Claim 22 depends from claim 21. Claim 21 recites a computer-implemented method of enabling a user of a processor system to purchase products for use with a peripheral device of the processor system. Claim 22 recites that the peripheral device is a printer.

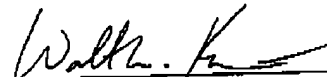
As set forth above, Oil Change Online discloses a service in which information about a user's processor system is kept within the user's processor system, and expressly is not communicated with a remote server. Feature Finder discloses printer maintenance software that monitors levels of maintenance items and flashes a contact information number when maintenance is needed. Neither reference discloses a method which includes informing a remote server system of the particular type of peripheral device of a user's processor system (for example, information about the printer component) is transmitted via a communications network. In addition, neither reference teaches transmitting a purchase invitation to the user's processor system specifying available compatible products. Specifically, Feature Finder makes no reference to transmitting a purchase invitation based on received information which identifies a printer of the user's processor system. Furthermore, incorporating this transmission would defeat the functionality of the service disclosed by Oil Change Online. Oil Change Online expressly does not communicate any information about the user's processor system to a remote server, via a communications network or otherwise. Since no information is communicated to a remote server in Oil Change Online, no purchase invitation based on this information and specifying compatible products could be transmitted to the user's processor system, as is recited in claim 22. Claim 22 is therefore not obvious in view of the cited references. Moreover, claims 23-

28 depend from and include all of the features of claim 22, and thus also are not obvious in view of the cited references.

Applicants believe that this application is now in condition for allowance, in view of the above remarks. Accordingly, applicants respectfully request that the Examiner issue a Notice of Allowability covering the pending claims. If the Examiner has any questions, or if a telephone interview would in any way advance prosecution of the application, please contact the undersigned attorney of record.

Respectfully submitted,

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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being facsimile transmitted to Examiner J. Smith, Group Art Unit 3625, Assistant Commissioner for Patents, at facsimile number (703) 305-7687 on October 14, 2003.


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